UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,121	05/09/2001	Robert G. Watkins	06975-071002	2317

26171	7590	11/23/2004	

EXAMINER
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ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 August 2002_.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-42_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-5,10-21,25-34, and 38-42_ is/are rejected.
7)☒ Claim(s) _6-9,22-24 and 35-37_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _8_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement (IDS) submitted on August 5, 2002 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

Specification

2.   The abstract of the disclosure is objected to because the current status of U.S.

Application No. 09/749,638 is not currently recited. The specification should be

amended to indicate that the application is abandoned. Correction is required. See

MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-5,10,14-21,25,29-34,38, and 42 are rejected under 35 U.S.C. 102(e) as

being anticipated by Colvin, U.S. Patent 6,044,471.

As per claims 1,17, and 30, it is disclosed by Mott et al of a method, apparatus, and machine (computer) readable medium having a sequence of instructions (computer program) stored thereon for identifying whether or not a client computer (communication system) is authorized or unauthorized by a software manufacturer (residing at a host communication system)(col. 1, line 65 through col. 2, line 4 and col. 3, lines 48-54). The examiner notes that Colvin monitors the number of users for software products to determine who is authorized and unauthorized and that computer specific information is also checked to uniquely identify the particular computer (client communication system) (col. 1, lines 65-67 and col. 4, lines 61-66). The computer (client communication system) stores (located at a memory segment) computer specific information that is used to monitor and determine if authorized or unauthorized (col. 2, line 65 through col. 3, line 8 and col. 4, line 61-66). It is noted that the retrieval of this information occurs automatically, or is an automated approach, that is used to access the software manufacturer (residing at a host communication system)(col. 2, lines 1-4 & 65-67). It is determined if the client software stored (located at a memory segment) corresponds to client software that is authorized (official client communication system) and it is determined that the client software is unauthorized when the client software stored (located at a memory segment) does not correspond to the client software that is authorized (official client communication system)(col. 1, lines 65-67, col. 4, line 61 through col. 5, line 10).

As per claims 2,18, and 31, it is disclosed by Colvin that the version of the client software used by the computer (client communication system) is monitored (col. 4, lines

2-5 and col. 5, lines 56-67). The computer (client communication system) stores (located at a memory segment) computer specific information that is used to monitor and determine if usage is authorized or unauthorized (col. 2, line 65 through col. 3, line 8 and col. 4, line 61-66).

As per claims 3,19, and 32, it is taught by Colvin that registration information is compared indicating the type of client software from the computer (client communication system) when a communication session is initiated (col. 2, line 65 through col. 3, line 8 and col. 4, line 61-66).

As per claims 4,20, and 33, it is disclosed by Colvin that the version of the client software used by the computer (client communication system) is monitored (col. 4, lines 2-5 and col. 5, lines 56-67). The computer (client communication system) stores (located at a memory segment) computer specific information that is used to monitor (diagnostic) and determine if usage is authorized or unauthorized (col. 2, line 65 through col. 3, line 8 and col. 4, line 61-66).

As per claims 5,21, and 34, Colvin teaches of locating memory segments in the user's computer (client communication system) that includes client software that remains unchanged in the memory segments (col. 4, lines 2-5 & 55-66 and col. 5, lines 56-67).

As per claims 10,25, and 38, Colvin discloses of determining whether the client software corresponds to official software that compares the client software stored in the identified memory segment with the corresponding client software of the official client communication system (col. 4, lines 2-5 & 55-66 and col. 5, lines 56-67).

As per claims 14 and 42, it is taught by Colvin of terminating communications from the client communication system when the client software stored in the memory segment is determined to diverge from predictable client software for an official client communication system (col. 2, line 63 through col. 3, line 14).

As per claim 15, Colvin discloses of terminating communications is performed after a predetermined and intentional delay once the client communication system is identified as an unauthorized client communication system (col. 2, line 63 through col. 3, line 14).

As per claims 16 and 29, Colvin recites of sending a notification to the user of the client communication system indicating identification of an unauthorized client when the client software stored in the memory segment is determined to diverge from the predictable client software for an official client communication system (col. 2, line 44 through col. 3, line 14).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 11-13,26-28, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin, U.S. Patent 6,044,471 in view of Houser et al, U.S. Patent 5,606,609.

As per claims 11,26, and 39, Colvin discloses of determining if software is authorized to be used on a computer. The teachings of Colvin are silent in disclosing of performing a mathematical computation on contents and comparing the results from the mathematical computation against a mathematical representation for the corresponding client software. It is disclosed by Houser et al of using a hash value calculator (mathematical computation) on an electronic document (contents stored on a memory segment) and calculating a hash value that is compared against a hash value that is extracted (mathematical representation for the corresponding client software)(col. 4, lines 19-34). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply measures to ensure the security of protected documents against illegal modifications. The teachings of Houser et al recite motivation for the use of hashing (mathematical computation) by disclosing that hashing is used to provide secure verification of the integrity of an electronic document (col. 3, lines 4-14). In light of the teachings of Houser et al, the teachings of Colvin would have further been improved to additionally protect the software against illegal modifications by checking for a hash value (mathematical computation) to determine if the integrity has been maintained, as is taught by Houser et al.

As per claims 12,27, and 40, Houser et al discloses of the usage of hashing (mathematical computation) that involves a checksum (col. 4, lines 19-34 and col. 12, lines 40-54).

As per claims 13,29, and 41, it is taught by Houser et al and the usage of hashing (mathematical computation) that involves the Secure Hash Standard (hashing algorithm)(col. 4, lines 19-34 and col. 12, lines 40-54).

Allowable Subject Matter

7.   Claims 6-9,22-24, and 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic
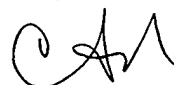
Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak
AU 2131

CR
November 22, 2004